

**IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE**

Inventors: Amy E. Messner et al. **Examiner:** James W. Myhre
Application No: 09/915,691 **Group Art Unit:** 3622
Filing Date: 07/25/2001 **Confirmation No:** 7616
Title: Method and Apparatus for Redeeming of Coupons via a Wireless
Communication Device

Assistant Commissioner for Patents
Washington, D.C. 20231

**APPELLANT'S BRIEF
UNDER 37 C.F.R. §41.37
(SUBSTITUTE)**

To The Commissioner of Patents and Trademarks:

The present substitute brief is in furtherance of the Notice of Appeal mailed February 21, 2006 and the Notification of Non-Compliant Appeal Brief mailed July 14, 2006, in connection with the above captioned application.

I. Real Party in Interest

The inventor has assigned all rights and interest in the above captioned application for patent to the Hewlett-Packard Company as evidenced by the assignment recorded at Reel 013436, Frame 0717 (2 pages) and subsequently reassigned to the Hewlett-Packard Development Company evidenced by the assignment recorded at Reel 014061, Frame 0492.

II. Related Appeals and Interferences

No other appeals or interferences are pending in the above captioned application.

III. Status of Claims

Claims 1-3 of the present application have been rejected and the rejections of claims 1-3 are being appealed. Claims 1-3 have been finally rejected under 35 U.S.C. 103(a). Claims 4-23 have been cancelled.

IV. Status of Amendment

A proposed Amendment After Final Rejection was mailed on January 19, 2006 and provided Appellant's reasons for Appellant's belief that the invention claimed in the present application is not obvious in view of the cited art. The reasoning provided in the proposed Amendment After Final was not deemed to overcome the rejection under 35 U.S.C. 103. Appellant's Amendment After Final is to be entered for purposes of appeal.

V. Summary of Claimed Subject Matter

The present invention is directed to a coupon delivery and wireless redemption system in which a coupon service provider (illustrated as reference numeral 130 in FIG. 1 and described in paragraph 0017, for a preferred embodiment) receives coupon and discount information from one or more merchants or advertisers (illustrated for a preferred embodiment as reference numeral 124 in FIG. 1). The coupon service provider is coupled to a public wide area network (for example, the Internet, illustrated for a preferred embodiment as reference numeral 110 in FIG. 1 and described in paragraph 0012) which enables communication between the coupon service provider and a merchant (see, for example, paragraphs 0016 and 0020) or an ISP (see, for example, paragraph 0015).

A public wireless network (illustrated for a preferred embodiment as reference numeral 108 in FIG. 1) provides access to the public wide area network for a transportable communication unit (illustrated for a preferred embodiment as reference numeral 106 in FIG. 1) and enables delivery (illustrated for a preferred embodiment as reference numeral 401 in FIG. 4A) of an electronic coupon to the transportable communication unit (as described in paragraphs 0012 and 0021).

A merchant includes a short range private wireless receiver (illustrated for a preferred embodiment as reference numeral 120 in FIG. 1) coupled to a redemption device (illustrated for a preferred embodiment as reference numeral 122 in FIG. 1) such that the transportable communication unit may tender an electronic coupon via the short range private wireless receiver (as described in paragraph 0021 in association with reference numeral 411 for a preferred embodiment).

Once the electronic coupon is tendered, evidence of the first merchant being valid is conveyed to the coupon service provider via the public wide area network (as described in paragraph 0021 in association with reference numerals 419 and 421 of FIG. 4A for a preferred embodiment). Approval to redeem the coupon is conveyed from the coupon service provider to the redemption device via the public wide area network (as described in paragraph 0021 in association with reference numeral 435 of FIG. 4B for a preferred embodiment).

VI. Grounds of Rejection to be Reviewed on Appeal

Whether claims 1-3 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over USP 5,420,606 to Begum et al. ("Begum") in view of USP 5,905,246 to Fajkowski ("Fajkowski").

VII. Argument

Examiner has rejected claims 1-3 under USP 5,420,606 to Begum et al. in view of USP 5,905,246 to Fajkowski. A rejection under §103(a) requires that "...the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains..." 35 U.S.C. 103(a). The investigation of obviousness has been well defined in Graham v. Deere, 383 U.S. 1, 148 USPQ 459 (1966). Three factual inquiries are to be made when performing analysis under §103: 1) the scope and content of the prior art are to be determined; 2) the differences between the prior art and the claimed invention are to be ascertained; and 3) the level of ordinary skill in the pertinent art is to be resolved. In the present Appeal, we look first to the first and second Graham inquiries to determine whether the scope and content of the cited art disclose pertinent art, and whether that disclosed art is different than Appellants' claims 1-3. In this instance where the rejection is based upon two references, if limitations found in Appellants' claims are simply not found in those cited references, alone or in combination, Examiner has not met the burden of a showing of a *prima facie* case of obviousness and the §103 rejection is improper.

It is Appellants' contention that the references cited against claim 1 do not, independently or combined, teach or disclose at least the claimed limitations of:

a) a first merchant of a plurality of valid merchants that conveys a coupon tender and evidence of the first merchant being valid to the coupon service provider via the public wide area network;

b) a coupon service provider that delivers an electronic coupon to a transportable communications unit via the public wide area network and the public wireless network; and

c) a coupon service provider that conveys an approval to redeem the coupon via the public wide area network to the redemption device of the first merchant.

Scope and content of the cited art:

Begum discloses an in-store electronic couponing system in which a transportable communication unit (14) is provided a plurality of coupons, which the user may display

on a display screen and select through a control. The selected coupon may be wirelessly transmitted to an electronic coupon interface unit (45) at check out such that the coupon discount is automatically deducted from the purchase total. See col. 2, lines 5-47. The coupon and deduction information is relayed to a coupon redemption file in the store's main computer (49) and to a systems controller (50). Periodically, the systems controller (50) communicates with a coupon redemption center computer for coupon crediting and accounting. See col. 5, lines 19-39. Appellant observes that this communication may take place over "...an outside communications link such as a modem for communication with a regional or national network. In this manner, *editing, accounting and monitoring of systems performance can be done* locally at the store site, or remotely from a regional or national center where promotionals are solicited and display graphics are created." Col. 3, lines 37-43 (emphasis added). Following the check-out procedure, the coupon file in the communication unit (14) is cleared. Col. 5, lines 1-5. In an alternative embodiment, the communication unit (14) is provided a transceiver so that it may receive data and be loaded with coupon information remotely. See col. 5, lines 40-44.

Fajkowski discloses a system and apparatus that electronically reads and stores bar codes from paper coupons (and elsewhere) and electronically presents the bar codes for redemption. Col. 1, lines 9-14. A portable coupon card, for use by a user, includes a bar code scanner, a memory, a display, a communications port, a microprocessor, and operational keys. Col. 3, lines 55-60. The user is able to scan paper bar codes into the coupon card for storage and organization. Col. 4, lines 7-11. A retail store is outfitted with a periphery device alongside its cash register to accept the coupon card, read the coupon bar codes, receive data from the cash register indicating which products were purchased, and determine which coupons are redeemable. Col. 4, lines 15-33. A retail local server may be networked into a plurality of periphery devices to *compile* information concerning which coupons have been redeemed and to create detailed reports for store managers. The server may also transfer information relating to future coupons or changes to the periphery devices for subsequent loading onto the user's portable coupon card. Col. 4, line 65 - col. 5, line 14. A clearinghouse receives information on redeemed coupons from the retailer's server and generates reports for the manufacturer

regarding amounts to be paid the retail store for the redeemed coupons. The clearing house may also provide coupon information and changes to the server for eventual loading onto a user's portable coupon card. Col. 5, lines 14-65. In addition to the periphery device, coupon information may be presented to a user's portable coupon card by: a) paper bar codes, b) distribution to conventional computers via the Internet (and subsequent magnetic writing to the coupon card), c) telephone lines, and d) radio frequency transmission to a receiver, for example a digital pager. Col. 6, lines 1-65.

Fajkowski includes a fraud prevention technique to reduce intentional *retailer* misredemption to increase retailer profits. The retailer is required to provide appropriate invoices to support coupon submissions. If the retailer does not, the retailer is placed on a suspend list by the manufacturer. Col. 3, lines 16-34 (emphasis added). Redeemed coupon data collected by the local server from the periphery devices are used to create redemption reports for the retailer (to detect fraud at a particular periphery device) but such data are securely stored so that the retailer cannot access or alter the data. Col. 22, lines 15-27. The server communicates redeemed coupon data to the clearinghouse, where it is compiled into a report of the total amount of redemptions per store and a report of the amounts owed by the manufacturer. Col. 23, lines 6-32. The clearinghouse may also transmit future coupons to the server. Col. 23, lines 54-64.

Differences between the cited art and Appellant's claimed invention:

Claim 1

a) Claim 1 requires that "a tender of said coupon...and evidence of said first merchant being valid is conveyed to the coupon service provider via said public wide area network". Begum's systems controller *periodically* communicates with a coupon redemption center computer for coupon *crediting and accounting*. Col. 5, lines 19-39. Fajkowski's server *compiles* information concerning which coupons have been redeemed and sends the information to a clearinghouse to enable payment by the manufacturer. With regard to Fajkowski's fraud prevention technique, the retailer is required to provide appropriate invoices to support coupon submissions. If the retailer does not, the retailer

is placed on a suspend list by the manufacturer. Col. 4, line 65 - col. 5, line 65. In both Begum and Fajkowski, the coupon information is compiled and sent for later crediting and fraud detection. The requirement of claim 1 is that the particular coupon being presented for redemption, rather than a compilation of many coupons, is conveyed to the redemption device. And it is to the particular coupon that the redemption device provides approval. Neither Begum nor Fajkowski, alone or together, teach or suggest this coupon approval and merchant validation.

b) Claim 1 requires that a *public wireless* network be coupled to the public wide area network. While Begum discloses the use of radio/microwave (i.e., wireless) at column 5, lines 31-39, Begum does not teach that the radio/microwave is coupled to the public wide area network. In fact, by presenting telephone as a distinct *alternative* to radio/microwave, Begum clearly demonstrates a teaching that a *public wireless* network is not connected to a public wide area network. Moreover, the radio/microwave taught by Begum is not disclosed to be a public wireless network, rather, it is expected that such a radio/microwave would be a private link. Fajkowski suggests that a coupon may be delivered by way of a coupon card service provider broadcasting a pager signal "by way of digital pager frequency radio waves" (col. 6, lines 60-67), but this suggestion does not include a *public* wireless network coupled to the *public* wide area network.

Examiner has indicated that Begum discloses that promotions are transmitted through a modem for communication *with* a regional or national network. Because of Begum's use of the word "network", Examiner essentially equates Begum's regional or national "network" with a public wide area network, such as the Internet. It is an important distinction that Begum does not suggest this regional or national network is a communications network (note that the communication is "with" not "over" or "through" or "via"), rather, as emphasized above, Begum teaches a regional or national network is a remote *center* for "...editing, accounting, and monitoring of systems performance... where promotionals are solicited and display graphics are created." Col. 3, lines 39-43. This teaching is consistent with a conventional definition of network: "a group, system, etc. of interconnected or cooperating individuals". (Webster's New World Dictionary, Second College Edition, Simon & Schuster, 1980). Thus, Applicant believes the

equation of Begum's regional or national network of cooperating individuals with a public wide area network like the Internet, to be unsupported by the disclosure of Begum.

Additionally, Claim 1 requires that "an electronic coupon is delivered to a transportable communication unit from the coupon service provider via said public wide area network *and* said public wireless network". Neither Begum nor Fajkowski alone or together disclose this required delivery path.

c) Claim 1 requires that "an approval to redeem said coupon is conveyed from said coupon service provider via said public wide area network to said redemption device". Begum teaches that coupon and deduction information is relayed to a coupon redemption file in the store's main computer - not the coupon service provider and not via the public wide area network. Fajkowski teaches the use of a periphery device alongside its cash register to accept a coupon card, read the coupon bar codes, receive data from the cash register indicating which products were purchased, and *determine which coupons are redeemable*. Even though Fajkowski's retail local server may be networked into a plurality of periphery devices to compile information concerning which coupons have been redeemed, this teaching is done later on a batch process and is not "an approval to redeem said coupon". Fajkowski's redemption is done by the periphery device without use of the public wide area network.

Therefore, since three major elements of Appellants' claim 1 are missing from the cited references, one of ordinary skill in the relevant art need not be tested to supply the missing elements. "To imbue one of ordinary skill in the art with knowledge of the invention is suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher". W.L. Gore Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-313 (Fed. Cir. 1983), *cert denied*, 469 U.S. 851 (1984).

Claim 2

Claim 2 is dependent upon independent and believed allowable claim 1. Claim 2 further limits the merchant of claim 1 such that the merchant includes an interface

coupled to the public wide area network for communication with the coupon service provider. Appellant's computer and its associated memory are coupled to the private short range wireless transceiver to accept a signal, convey coupon information to the coupon service provider via the interface, and accept coupon approval from the coupon service provider via the interface. When the coupon is approved, the redemption device, coupled to the computer, calculates a price for an item. Since claim 2 requires that "a computer and associated memory...accept coupon approval from said coupon service provider" and since neither Begum nor Fajkowski, alone or in combination, teach or suggest that coupon *approval* is received from the *coupon service provider*, the rejection of claim 2 under §103 is improper.

Claim 3

Claim 3 is dependent upon independent and believed allowable claim 1. Claim 3 further limits the transportable communication unit of claim 1 such that a first transceiver is enabled to communicate with the public wireless network to receive delivery of the electronic coupon. A processor and memory store the received electronic coupon. A user interface provides indication of the stored electronic coupon and accepts a user activation to tender the stored coupon. The tender is communicated by way of a second transceiver to the coupon redemption device. Since claim 3 requires that the transportable communication unit include "a first transceiver adapted to communicate with said public wireless network coupled to said public wide area network" and since neither Begum nor Fajkowski, alone or in combination, teach or suggest that coupling of public wireless network coupled to public wide area network, the rejection of claim 3 under §103 is improper.

Combination of References:

The foregoing assumes that the combination of Begum and Fajkowski is proper. There is, however, no concrete motivation, suggestion, or teaching in Begum and

Fajkowski to make the combination used by Examiner. Modern interpretation of §103 "requires that there be some suggestion, motivation, or teaching in the prior art whereby the person of ordinary skill would have selected the components that the inventor selected and used them to make the new device." C.R. Bard Inc. v M3 Systems Inc., 157 F.3d 1340, 1351, 48 USPQ 2d 1223, 1231 (Fed. Cir. 1998). In particular, "it is insufficient that prior art shows similar components, unless it also contains some teaching, suggestion, or incentive for arriving at the claimed structure." Bard, 157 F.3d at 1351, 48 USPQ 2d at 1232. Also see ACS Hospital Systems, Inc. v Montefiore Hospital et al., 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). While Fajkowski is directed to a method and apparatus for coupon management and redemption, and while Begum is directed to an in-store electronic couponing system in which a transportable communication unit is provided a plurality of coupons, any suggestion or incentive in these references to produce the combination used is notably absent. It is "clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (citations omitted). Appellants, therefore, contend that the combination is improper.

Conclusion:

In conclusion, Appellants have demonstrated that the claims of the present Application have been improperly rejected. Appellants respectfully request that the rejection of claims 1-3 under 35 U.S.C. 103(a) be reversed and the present Application be returned to Examiner for allowance.

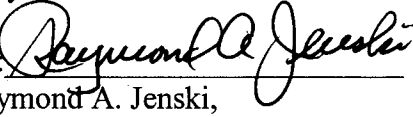
The text of the claims on appeal are double spaced and attached hereto as Appendix VIII.

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VIII. CLAIMS APPENDIX

Claims involved in the appeal:

1. A coupon delivery and wireless redemption system comprising:
 - a coupon service provider serving a plurality of valid merchants and coupled to a public wide area network;
 - a public wireless network coupled to said public wide area network;
 - a first merchant of said plurality of valid merchants coupled to said coupon service provider via said public wide area network and comprising a short range private wireless receiver coupled to a redemption device;
 - wherein an electronic coupon is delivered to a transportable communication unit from said coupon service provider via said public wide area network and said public wireless network, a tender of said coupon by said transportable communication unit made via said short range private wireless receiver and evidence of said first merchant being valid is conveyed to said coupon service provider via said public wide area network, and an approval to redeem said coupon is conveyed from said coupon service provider via said public wide area network to said redemption device.
2. A coupon delivery and wireless redemption system in accordance with claim 1 wherein said first merchant further comprises:
 - an interface coupled to said public wide area network for communication with said coupon service provider;

a computer and associated memory coupled to said private short range wireless transceiver and said interface to accept said signal from said private short range wireless transceiver, to convey coupon information to said coupon service provider via said interface, and to accept a coupon approval from said coupon service provider via said interface; and

said redemption device, being coupled to said computer such that a price for an item is calculated when said coupon is approved.

3. A coupon delivery and wireless redemption system in accordance with claim 1 wherein said transportable communication unit comprises:

a first transceiver adapted to communicate with said public wireless network coupled to said public wide area network to receive delivery of said electronic coupon;

a processor and associated memory that stores said received electronic coupon;

a user interface that provides a human perceptible indication of said stored electronic coupon and that accepts a user activation to tender said stored electronic coupon for redemption; and

a second transceiver adapted to communicate said tender to said coupon redemption device.

IX. EVIDENCE APPENDIX

Not applicable to the present application.

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X. RELATED PROCEEDINGS APPENDIX

No related decisions.